

UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandra, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,943	08/31/2001	David Mack	40053.011400	8966
75	590 07/02/2004		EXAM	INER N
Mark A. Wurm GREENBERG TRAURIG 12th FLOOR 1750 TYSONS BLVD			GREENE, DANIEL L	
			ART UNIT	PAPER NUMBER
			3621	
MCLEAN, VA	A 22102		DATE MAILED: 07/02/200-	4

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

		~ /	
Application No.	Applicant(s)	() X	A
09/942,943	MACK, DAVID	M 0	
Examiner	Art Unit		
Daniel L. Greene	3621		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE $\underline{3}$ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

after: - If the - If NO - Failur Any r	ensions of time may be available under the provisions of 37 CFR 1.136(a). In no e or SIX (6) MONTHS from the mailing date of this communication. e period for reply specified above is less than thirty (30) days, a reply within the station period for reply is specified above, the maximum statutory period will apply and the toreply within the set or extended period for reply will, by statute, cause the appreply received by the Office later than three months after the mailing date of this cated patent term adjustment. See 37 CFR 1.704(b).	atutory minimum of thirty (30) days will be considered timely. will expire SIX (6) MONTHS from the mailing date of this communication. plication to become ABANDONED (35 U.S.C. § 133).
Status		
2a) <u></u> 3) <u></u>	Responsive to communication(s) filed on <u>31 August 200</u> This action is FINAL . 2b) This action is Since this application is in condition for allowance except closed in accordance with the practice under <i>Ex parte Q</i>	non-final. It for formal matters, prosecution as to the merits is
Dispositi	ion of Claims	
5)□ 6)⊠ 7)□	Claim(s) 1-50 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from conclaim(s) is/are allowed. Claim(s) 1-50 is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restriction and/or election	
Applicati	ion Papers	
10)⊠	The specification is objected to by the Examiner. The drawing(s) filed on 31 August 2001 is/are: a) access applicant may not request that any objection to the drawing(s) Replacement drawing sheet(s) including the correction is required to by the Examiner. No	be held in abeyance. See 37 CFR 1.85(a). red if the drawing(s) is objected to. See 37 CFR 1.121(d).
Priority u	under 35 U.S.C. § 119	
a)[Acknowledgment is made of a claim for foreign priority un All b) Some * c) None of: 1. Certified copies of the priority documents have been as Copies of the certified copies of the priority documents have been application from the International Bureau (PCT Russee the attached detailed Office action for a list of the certified copies.	en received. en received in Application No nents have been received in this National Stage alle 17.2(a)).
2) Notice 3) Inform	ce of References Cited (PTO-892) ce of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	4) Interview Summary (PTO-413) Paper No(s)/Mail Date 5) Notice of Informal Patent Application (PTO-152)

3) 🖂	Information
------	-------------

Art Unit: 3621

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 2. Claims 1-3, 27-29 and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al. U.S. Patent 6,658,568 [Ginter]
- 3. As per claims 1, 27, and 50:
- 4. Ginter discloses:
- 5. means for analyzing content of a file being accessed by a local computer; and means for identifying if the content is proprietary. Fig. 42, Col. 73-74, lines 1-67.

As per claims 2 and 28:

Ginter further discloses:

means for blocking the file from being transferred across a network. Rights Templates Figs. 45A and 45B. Col. 75-76, lines 1-67.

As per claims 3 and 29:

Ginter further discloses:

means for modifying the file before transferring it. Col. 95-96, lines 1-67.

Application/Control Number: 09/942,943 Page 3

Art Unit: 3621

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 2. Claims 4-26, 30-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. U.S. Patent 6,658,568 [Ginter] .
- 3. As per claims 4-8, and 30-34:

Ginter does not expressly show the specific type of modifications disclosed in the aforementioned claims. However these differences, adding dead air to a music file, adding an advertisement to a movie file, adding noise, cutting off a portion of it, and corrupting it, are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The modifying of the file before transferring it, would be performed the same regardless of the type of modification done. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify a file before transferring with any type or kind

Art Unit: 3621

of data, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 9 and 35:

Ginter discloses the claimed invention, as discussed above, except for the step of generating a tag corresponding to the data. However, Ginter does teach about generating templates that correspond to digital control sets associated with properties, content users, user classes, and/or digital information and/or physical or virtual sites and/or process control for event and event consequences governance. Col. 69-70, lines 1-67. The templates by their very nature provide "tags" that are utilized when a specific piece of data is referenced. Since the applicant has not disclosed that generating a tag corresponding to the data. solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Ginter will perform the invention as claimed by the applicant with any means, method, or product to generating a tag corresponding to the data.

As per claims 10-13 and 36-39:

Ginter does not expressly show what the tags include. Ginter does teach about the different formats and the type of data that can be included in the templates. Col. 70, lines 1-67. Even though, Ginter does not specifically teach about the limitations

Art Unit: 3621

presented by the Applicant, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. generating a tag corresponding to the data steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made include any type of data in the tags because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 14-16, 17, and 40-43:

Ginter further discloses:

means for generating a tag further includes means for comparing the tag to other tags. Col. 96, lines 1-67.

As per claims 18-20:

Ginter further discloses:

wherein the means for analyzing and the means for identifying are embodied in software, hardware, and firmware. Col. 17, lines 1-30.

Art Unit: 3621

As per claims 21-26 and 44-49:

Ginter does not expressly show wherein the file includes at least one of an image, music, a movie, publishing content, an executable file, a video game, private health record, a pharmaceutical record, confidential personal documents, a will, a virus, a financial record, a CAD drawing, trade secret information, a customer list, and a confidential corporate document.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The file control system steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the files include any type of data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/24/04

DLG

OHN W. HAYES